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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Hogendoorn
Serial No.: 09/862,800
Filed: 05/21/2001
Group Art Unit: 3624
Examiner: Akers, Geoffrey R.
For: DUTCH AUCTION SYSTEM WITH PREREGISTERED
BID FEATURE

RESPONSE

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is responsive to the Office Action mailed on October 22, 2003 (Paper No. 4).

Applicant respectfully requests reconsideration of this application.

Applicant respectfully submits that there is no *prima facie* case of obviousness against any of the claims because there is no legal motivation for making the proposed combinations. Where a proposed combination provides no benefit, there is no motivation to combine and no *prima facie* case of obviousness.

Applicant respectfully submits that there is no benefit to combining *Godin* and *Barzilai*. There would be no benefit to adding a preregistered bid from *Barzilai* to the

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Godin system. The *Godin* reference repeatedly teaches removing a user from the process once a bid is received. This is discussed, for example, in the abstract, column 2, lines 15-18, and column 3, line 67 - column 4, line 4. Because *Godin* intentionally removes a participant from an auction once a bid is received, there would be no benefit to providing preregistered bids because those individuals would be removed from the process before it even began. Accordingly, adding a preregistered bid from *Barzilai* has no benefit in *Godin* and has no real use. The combination therefore cannot be made.

Applicant respectfully traverses the rejection of claims 17-20 based upon the proposed combination of *Godin* with *Friedland*. There is no benefit to adding the time delay features of *Friedland* to the arrangement of *Godin* because *Godin* does not include a live auction. Instead, *Godin* is purely internet based so any timing delays are the same for everyone. There is no live auction clock in *Godin* and, therefore, no benefit to adding an arrangement as taught by *Friedland* for accommodating differences between a live auction clock and remote bidders. Without any benefit, there is no motivation for the combination and no *prima facie* case of obviousness.

Applicant respectfully traverses the rejection of claim 21 based upon *Godin* combined with *Friedland* and *Barzilai*. As indicated above, there is no motivation for combining *Godin* with either of the two references and the combination of all three of them does not provide sufficient motivation, either. Because *Godin* does not have a live auction, there is no benefit to adding the teachings of *Friedland* or *Barzilai*.


Applicant respectfully submits that this case is in condition for allowance. If the Examiner believes a telephone conference will facilitate moving this case forward to

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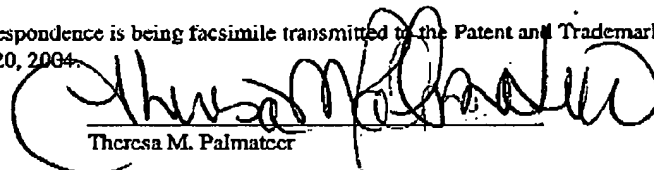
being issued, Applicant's representative will be happy to discuss any issues regarding this application and can be contacted at the telephone number indicated below.

Respectfully submitted,

CARLSON, GASKEY & OLDS

By: 
David J. Gaskey
Registration No. 37,139
400 W. Maple Rd., Ste. 350
Birmingham, MI 48009
(248) 988-8360

Dated: January 20, 2004

<p style="text-align: center;"><u>CERTIFICATE OF FACSIMILE</u></p> <p>I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9306) on January 20, 2004.</p> <p style="text-align: center;"> Theresa M. Palmatier</p>
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